

REMARKS

Interview

Applicant would like to thank the Examiner for the courtesy extended to Applicant's attorney during the interview on August 20, 2009. The remarks submitted herein reflect the substance of the interview.

Status of the Claims

Claims 1, 5-30, and 35-68 are pending in this application. Claims 1, 27, 54-56, 61, and 68 are independent. In the Office Action, claims 66-68 were rejected under 35 U.S.C. § 112, first paragraph. In addition, claims 1, 5-11, 14-18, 27, 36-44, 47-52, 54-57, 59, 60, and 65-68 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over CA 2186042 to Gueret (hereinafter "the '042 patent"). Further, claims 19-26, 28-30, 35, 45, 46, 53, and 58 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over the '042 patent in view of Kochinke (U.S. Patent No. 5,350,581; hereinafter "Kochinke"). Finally, claims 12, 13, and 61-64 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over the '042 patent in view of Yoko (JP 04108710; hereinafter "Yoko").

Applicant would like to thank the Examiner for the withdrawal of the rejection of claim 9 under 35 U.S.C. § 112, first paragraph, and the withdrawal of the rejection of claim 14 under 35 U.S.C. § 112, second paragraph.

Rejection of Claims 66-68 Under 35 U.S.C. § 112, First Paragraph

Claims 66-68

Claims 66-68 were rejected under § 112, first paragraph, because the claim limitation specifying that the composite structure has a "substantially constant thickness"

is allegedly not supported in the original disclosure. Final Office Action at 3. Applicant respectfully submits that this limitation is supported by at least the originally filed drawings and that, therefore, the § 112, first paragraph, rejection of claims 66-68 should be withdrawn.

The Office Action cites several passages in Applicant's specification, which describe exemplary embodiments of the disclosed composite having support layers that "can be of different thicknesses." Final Office Action at 3. Applicant respectfully submits that it is irrelevant whether some layers have a thickness that is different from the thickness of other layers or whether layer thicknesses vary along the length of the article because each of claims 66-68 requires that the "composite structure" (not necessarily each of its individual subparts such as each layer) has a substantially constant thickness.

Applicant also respectfully disagrees with the lack of written description allegation based on an assertion that the figures show merely a portion of a whole article. First, Applicant respectfully submits that only some of the figures in Applicant's application illustrate a truncated portion of an article, while others illustrate an entire article. Second, there is nothing in the specification that suggests the non-truncated composite structures shown in the figures are representations of only portions of those composite structures. Third, there are, in fact, descriptions in the specification indicating that one or more of Applicant's figures illustrate a complete article.

While Figures 14 and 15 show curvy lines at each end, indicating that the drawing of the article has been truncated for purposes of illustration, the composite structures shown in Figures 1-10 do not include such curvy lines. There is nothing in

the specification that would indicate any of Figures 1-10 depict merely a portion of an article. Applicant respectfully submits that, absent any teaching that any of Figures 1-10 depict merely a portion of an article, the use of curvy lines to show truncation in some drawings (i.e., Figures 14 and 15), but not in Figures 1-10, indicates that Figures 1-10 depict complete articles.

Moreover, the specification indicates that particular types of composite structures having the configurations of figures 1-10 are contemplated. For example, the specification indicates, at page 9, lines 27-28, that "[b]y way of example, a cleaning disk has been made having structure as shown in Figure 2." Therefore, Figure 2, which shows a composite structure having a substantially constant thickness, illustrates an article as a whole.

The final Office Action alleges that "the figures do not show any thickness," and that "nothing in the specification indicate[s] that figures 1-10 depict the whole article." Final Office Action at 4. Applicant respectfully submits that Figures 1-10 clearly illustrate articles having thickness, since the upper and lower surfaces of the articles are clearly shown to be spaced apart by a visible distance. Applicant's claim term "substantially constant thickness" is supported by these drawings because the visible distance separating the upper and lower surfaces, as illustrated in Figures 1-10, is substantially constant. Applicant further submits that even if there were small scale differences along the length of the illustrated article, such differences would not be relevant because each of claims 66-68 requires that the composite structure has a substantially constant thickness.

For at least these reasons, Applicant respectfully submits that the original disclosure supports the claim term "substantially constant thickness." Accordingly, Applicant submits that the § 112, first paragraph rejection of claims 66-68 should be withdrawn.

Rejection under 35 U.S.C. §103(a)

Applicant respectfully submits that the rejection of claims 1, 5-11, 14-18, 27, 36-44, 47-52, 54-57, 59, 60, and 65-68 under 35 U.S.C. §103(a) should be withdrawn because the '042 patent fails to disclose or suggest all of the recited features of independent claims 1, 27, 54-56, and 68.

Independent Claim 1

For example, the '042 patent does not disclose or suggest a composite structure for at least one of treating, making up, and cleaning a surface region, the composite structure comprising, among other things,

at least two non-adhesive layers, at least one of the two non-adhesive layers being permeable to a solvent and defining an outer surface of the composite structure, the outer surface being configured to be placed into contact with the surface region . . . [and]

at least one adhesive matrix between the two non-adhesive layers, the adhesive matrix comprising a permanent adhesive, the two non-adhesive layers being permanently bonded to the adhesive matrix,"

as recited in independent claim 1. Emphasis added.

The final Office Action alleges that the '042 patent discloses a patch comprising "1) the occlusive layer non-adherent, that is not the removable protective layer; 2) [an] adhesive matrix; and 3) [a] net perforated layer embedded in the matrix[.]" Final Office Action at 9. The final Office Action further alleges that "[t]he claims do not exclude the

presence [of other] layers such as part of the adhesive matrix on the other side of the perforated net, nor require more than one layer being non-adhesive.” *Id.* at 9-10. Applicant respectfully points out that the claims do, in fact, require more than one non-adhesive layer, and specifically exclude the presence of other layers on one surface of at least one layer that is permeable to the solvent. For example, claim 1 recites “at least two non-adhesive layers,” and further specifies that “at least one of the two non-adhesive layers [is] permeable to a solvent and defin[es] an outer surface of the composite structure, the outer surface being configured to be placed into contact with [a] surface region.” Accordingly, even if the net disclosed in the ‘042 patent were embedded in the adhesive matrix, it would not constitute a second non-adhesive layer “being permeable to a solvent and defining an outer surface of the composite structure.” Further, as discussed in greater detail below, the ‘042 patent does not disclose the nylon net being embedded in the adhesive matrix. Rather, it is positioned between the adhesive matrix and the occlusive support layer.

Applicant submits herewith a copy of U.S. Patent No. 6,063,398 (the ‘398 patent), which provides an English-language translation of a continuation-in-part of a U.S. counterpart to the ‘042 patent.¹ Applicant notes that the translation of the ‘042 patent cited in the final Office Action is an automated Google translation of the ‘042 patent as it appears on www.wiki.patents.com. Like many machine/automated translations, the quality is less than adequate for certain portions of the document. As

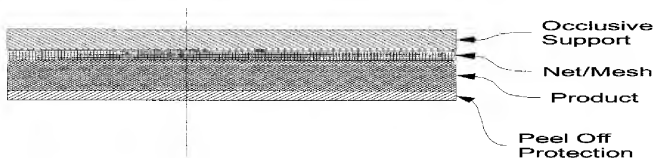
¹ Applicant further notes that U.S. Patent No. 6,063,398 claims priority to the same French priority application as the ‘042 patent, FR 95 11030, and is a continuation-in-part of U.S. Application No. 08/715,822, which is a U.S. counterpart to the ‘042 patent. Thus, portions of U.S. Patent No. 6,063,398 correspond to the ‘042 patent and provide an English-language translation thereof. If the Examiner would like submission an English-language translation of the ‘042 patent, the Examiner is cordially invited to call Applicant’s undersigned attorney to discuss this issue.

discussed during the interview, the EXAMPLE section of the '042 patent discloses a self-adhesive product that is

fed into a hopper and spread using a scraper in a layer 0.8 mm thick on a polyethylene sheet having a thickness of 200 μm . This sheet could be preliminary surface-treated to reduce adhesiveness. A framework consisting of a polyamide or polyethylene net whose meshwork had openings measuring 1 mm and which had a thickness of 0.3 mm was incorporated into the polyethylene sheet treated in this way.

See the '398 patent at col. 7, lines 1-8.

According to the EXAMPLE section of the '042 patent (*see id.* at col. 7, lines 9-16), a 30 μm support or occlusive layer is then deposited, thus producing a "unit comprising an occlusive support layer and a self-adhesive storage layer formed from a partially cross-linked silicone polymer matrix, this unit further comprising a detachable protective layer." Therefore, a proper construction of the disclosure is shown below in Exemplary Fig. 1.



The sheet of polyethylene referred to in '042 is the peel off protection layer, which is why it is pre-treated on a surface to reduce its adhesion. Next comes the self-adhesive storage layer (i.e., for storing the product), then the nylon net/mesh, and finally the occlusive support layer. This construction is further supported by the specification text of the '042 patent (*see id.* at col. 6, lines 19-40), which describes, in order, the steps

of mixing the product, spreading the product onto the removable protective layer, placing the framework (i.e., the net/mesh) on top of the product, and then placing the occlusive support layer on top of the net/mesh.

Thus, the adhesive layer is not between two non-adhesive layers, and neither of the non-adhesive layers is both permeable to a solvent and providing an outer surface of the composite structure, as required by independent claim 1. The occlusive support layer may constitute an outer layer, but is not disclosed as being permeable to a solvent (on the contrary, it is referred to as an "occlusive support layer"). The nylon net, alleged in the final Office Action to constitute a second non-adhesive layer, appears to be permeable to a solvent (since it is a net or mesh), but does not define an outer surface of the composite structure (it is between the occlusive support layer and the adhesive matrix).

Furthermore, as acknowledged by the Examiner during the interview of December 23, 2008, regardless of whether the matrix of the '042 patent includes a permanent adhesive, the '042 patent's detachable layer of protection cannot be equated with one of the claimed non-adhesive layers because the adhesive matrix is not permanently bonded to the detachable layer of protection. If it were, the layer of protection would not be detachable.

For at least these reasons, Applicant respectfully submits that the § 103(a) rejection of independent claim 1 based on the '042 patent should be withdrawn.

The final Office Action appears to acknowledge that the '042 patent lacks disclosure of the claim recitation regarding at least one of the non-adhesive layers defining an outer surface of the composite structure. Final Office Action at 7. However,

the final Office Action attempts to cure this acknowledged deficiency by apparently alleging that it would have been obvious to rearrange the layers of the article described in the '042 patent.

Applicant respectfully submits that the only two non-adhesive layers disclosed in the '042 patent that are permanently bonded to the adhesive matrix are the occlusive support layer and the nylon net, and that, as described above, the nylon net is disposed between the occlusive support layer and the adhesive matrix. Accordingly, it appears the Examiner is suggesting that it would have been obvious to relocate the nylon net on the other side of the adhesive matrix (i.e., opposite the occlusive support layer).

Applicant respectfully submits that there is no suggestion to relocate the nylon net to such a location and that, furthermore, one of ordinary skill in the art would have had at least one reason to refrain from doing so. Specifically, the adhesive matrix is disclosed to be a "self-adhesive" layer for application to the skin. See the '398 patent at col. 6, lines 50-54; col. 7, lines 14. Accordingly, it would not have been obvious to locate the nylon net on the skin-contacting surface of the adhesive matrix because it would likely prevent, or significantly inhibit, adhesion of the adhesive matrix to the skin. Therefore, the final Office Action fails to establish a prima facie case of obviousness with respect to independent claim 1.

Applicant respectfully submits that, for at least these reasons, the § 103(a) rejection of claim 1 should be withdrawn.

Independent Claims 27 and 54-56

Each of independent claims 27, 54, and 55 includes recitations corresponding to those discussed above in connection with claim 1. In addition, independent claim 56

includes similar recitations, specifying that the “support layers [form] external faces of the structure.” Therefore, the rejections of independent claims 27 and 54-56 under § 103(a) should be withdrawn for substantially the same reasons as those discussed above with respect to claim 1.

Independent Claim 68

With regard to independent claim 68, Applicant respectfully submits that the ‘042 patent fails to disclose a composite structure having, among other things, “a substantially constant thickness,” as recited in claim 68.

The final Office Action alleges that “[e]ven with pinched edges, the reference teaches substantial[ly] constant thickness in [the] absence of [a] definition of the relative term ‘substantially.’” Final Office Action at 10. The final Office Action also apparently attempts to support this conclusion by asserting that “no disclosure [is] made by the reference that the thickness is not constant.” *Id.* However, the ‘042 patent discloses that the composite structure can be obtained by cutting the desired forms, which produces pinched edges. See the ‘398 patent at col. 6, lines 44-47. Furthermore, the ‘042 patent does not disclose that the composite structure can have a substantially constant thickness. Applicant respectfully submits that, since the composite structure in the ‘042 patent is disclosed to have pinched edges, and is not otherwise disclosed to have a substantially constant thickness, the ‘042 patent does not satisfy the “substantially constant thickness” recitation of claim 68.

Regarding the assertion that “no disclosure [is] made by the reference that the thickness is not constant,” Applicant respectfully submits that the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.

MPEP § 2142. The Examiner does not provide any evidence establishing whether the '042 patent discloses or suggests a composite structure having a substantially constant thickness. Even if the reference lacked any indication one way or the other whether the disclosed structure has or does not have a substantially constant thickness, the fact that the reference does not mention the thickness being non-constant, by itself, would not indicate that the thickness is constant. Further, as noted above, Applicant respectfully submits that the '042 patent does, in fact, provide some indication that the thickness is not substantially constant. Specifically, the '042 patent discloses pinched edges.

In addition, because the '042 patent provides no indication that the disclosed composite structure has a thickness that is, in any way, constant, and furthermore, provides an indication that the thickness is, in fact, not constant (i.e., the pinched edges), the '042 patent does not meet the “substantially constant thickness” limitation, regardless of how broadly it is construed.

For at least these reasons, Applicant submits that no prima facie case of obviousness has been established with respect to independent claim 68 and that, accordingly, the § 103(a) rejection of independent claim 68 should be withdrawn.

Rejection of Claims 61-64 Under 35 U.S.C. § 103(a)

Claim 61

The rejection of claims 61-64 under § 103(a), based on the '042 patent in view of Yoko, fails to establish a prima facie case of obviousness, because the cited art does not disclose or suggest all of the recitations of independent claim 61. Claim 61 includes recitations similar to those discussed above for independent claim 1. That is, claim 61 recites “at least one of the two support layers being permeable to a solvent and defining

an outer surface of the composite structure, the outer surface being configured to be placed into contact with the surface region.” Thus, claim 61 is distinguishable over the ‘042 patent for reasons similar to those discussed above with respect to independent claim 1.

Yoko is cited only for an alleged teaching of a “cosmetic in adhesive matrix comprising magnetizable particles,” (final Office Action at 12), and fails to cure the above-noted deficiencies of the ‘042 patent. Therefore, the cited art does not disclose or suggest all of the recited features of independent claim 61, and thus, the Office Action fails to establish a prima facie case of obvious with respect to claim 61. Accordingly, Applicant respectfully submits that the § 103(a) rejection of claims 61-64 should be withdrawn.

Rejection of Dependent Claims 12, 13, 19-26, 28-30, 35, 45, 46, 53, and 58 Under 35 U.S.C. § 103(a)

Claims 12 and 13, each of which ultimately depends from claim 1, were rejected under § 103(a) based on the ‘042 patent and Yoko. As noted above, Yoko is cited solely for an alleged teaching of a “cosmetic in adhesive matrix comprising magnetizable particles,” (final Office Action at 12), and does not cure the deficiencies of the ‘042 patent discussed above with respect to claim 1. Accordingly, Applicant respectfully submits that the § 103(a) rejection of dependent claims 12 and 13 should be withdrawn.

Claims 19-26, 28-30, 35, 45, 46, 53, and 58 were rejected under 35 U.S.C. § 103(a) based on the ‘042 patent and Kochinke. Kochinke is cited solely for an alleged teaching of “more than one therapeutic agent contained in different adhesive matrices to deliver mixture of therapeutic agents.” Final Office Action at 11. Kochinke, however,

fails to cure the above-noted deficiencies of the '042 patent discussed above with respect to independent claims 1, 27, and 56, from which one or more of claims 19-26, 28-30, 35, 45, 46, 53, and 58 respectively depends. Applicant respectfully submits that, therefore, the § 103(a) rejection of claims 19-26, 28-30, 35, 45, 46, 53, and 58 should be withdrawn.

Conclusion

For at least the foregoing reasons, Applicant respectfully submits that each of independent claims 1, 27, 54-56, 61, and 68 is allowable. Each of claims 5-26, 28-30, 35-53, 57-60, and 62-67 ultimately depends from one of these allowable independent claims and, therefore, should be allowable for at least the same reasons that the respective claim from which it depends is allowable. Additionally, these dependent claims include further limitations that distinguish from the cited art.

In view of the foregoing remarks, Applicant submits that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's reconsideration of the application and the timely allowance of the pending claims.

The Office Action contains a number of statements reflecting assertions and/or allegations concerning the claims and/or cited art. Regardless of whether any such statement is identified above, Applicant declines to subscribe to any assertion or allegation in the Office Action.

Please grant any additional extensions of time required to enter this response
and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 28, 2009

By: /Jeremy T. Thissell/
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571.203.2717

Attachments:

- Copy of U.S. Patent No. 6,063,398
- Copy of Original French-language version of CA 2186042